



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,010	04/23/2004	Sheng-Yu Huang	BHT-3137-42	7641
7590 07/10/2008 TROXELL LAW OFFICE PLLC SUITE 1404 5205 LEESBURG PIKE FALLS CHURCH, VA 22041			EXAMINER KHATTAR, RAJESH	
			ART UNIT 3693	PAPER NUMBER
			NOTIFICATION DATE 07/10/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary**Application No.**

10/830,010

Applicant(s)

HUANG, SHENG-YU

Examiner

RAJESH KHATTAR

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

This office action is in response to Applicant's communication filed on 4/28/08. Claims 1-2 have been amended. As such, claims 1-4 are pending in the application.

Response to Arguments

Examiner withdraws claim objection in view of Applicant amending the claim to address the objection.

Applicant's arguments filed 4/28/2008 have been fully considered but they are not persuasive.

In response to applicant's argument (Remarks, page 5) that the present invention has a different objective which resolves current user's dilemma, be able to monitoring real-time financial market, and is easy to use, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present invention is enable to display a multiplicity of market...so as to allow the investors to simultaneously operate on a number of different kinds of stocks, trends of weighted average index of stock market and other financial commodities, Remarks, page 8) are not recited in the rejected claim(s). Although the claims are interpreted in

light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that all cited references have a disadvantage of which all kinds of technical indexes of chart or form data are individually exist in the traditional financial market and without entirely integrating those information or data (Remarks, page 10) and suggests that the cited reference teaches away from the claimed invention, Examiner notes that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." (see MPEP 2141.02 VI).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Art Unit: 3693

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner cited motivation for combining the references in the non-final office action dated 1/28/2008.

For reference, Examiner has reproduced the non-final office action dated 1/28/2008 as below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higgins, US Patent No. 5,270,922 in view of Garcia, US Patent No. 3,598,308 and further in view of Galant, US Patent No. 6,839,686. Higgins discloses a global financial commodity bull/bear positioning device, comprising a processing unit, an input unit, a display unit and a program unit, wherein the processing unit is in connection with the input unit and the display unit, the program unit is installed in the processing unit (Figure 1B, col. 1, lines 9-55) for display market disk on the display unit under the control of the processing unit, *the market disk comprising a disk base and rotating pieces, the disk base being comprised of a raising-up section and a lowering-down section both having circumference on which indexes are marked, each rotating piece being movable mounted to a top face of the disk base and having a positioning section corresponding to the raising-up and lowering-down sections of the disk base to provide indication of bull/bear markets of different period of time, the input unit entering values of the indexes*

of different time period, whereby the bull/bear market information of different time periods can be combined together and the rotating pieces are mounted on the disk base to allow for correctly handling of timing of selling/buying of financial commodities.

Higgins fails to specifically disclose *the market disk comprising a disk base and rotating pieces, the disk base being comprised of a raising-up section and a lowering-down section both having circumference on which indexes are marked, each rotating piece being movable mounted to a top face of the disk base and having a positioning section corresponding to the raising-up and lowering-down sections of the disk base to provide indication of bull/bear markets of different period of time.* However, Garcia discloses this limitation (Figure 6; col. 5, lines 24-56). Examiner notes that Garcia discloses a disc base and rotating pieces. Moreover, Examiner notes that the use of raising-up and lowering-down section with indexes marked is clearly an aesthetic design change (see MPEP § 2144.04). The design change that relates to ornamentation only and have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. Garcia discloses each rotating piece being movable mounted to a top face of the disk base and having a positioning section.

Therefore, it would have been obvious for a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Higgins to include the disclosure of Garcia. One would have been motivated to do so in order to provide means for calculating market yield on discount bonds as illustrated by Garcia (col. 2, lines 30-35).

Both Higgins and Garcia do not specifically disclose *the input unit entering values of the indexes of different time period, whereby the bull/bear market information of different time periods can be combined together and the rotating pieces are mounted on the disk base to allow for correctly handling of timing of selling/buying of financial commodities*. However, Galant discloses this feature (col. 23, lines 35-43; col. 32, lines 61-col. 33, lines 3). Therefore, it would have been obvious for a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Higgins and Garcia to include the disclosure of Galant. One would have been motivated to do so in order to permit a user to select any of a variety of indices as illustrated by Galant.

Examiner has given little/no patentable weight to the "whereby" clause as it doesn't limit a claim to a particular structure (MPEP § 2106).

Regarding claim 2, Garcia discloses wherein the rotating pieces each comprise a circular disk of different radius moveably mounted on the top face of the disk base (Figure 6, col. 5, lines 24-56).

Regarding claims 3-4, Examiner notes that the use of K and D numbers of KD indicator and RSI number of RSI indicator is clearly an aesthetic design change (see MPEP § 2144.04). The design change that relates to ornamentation only and have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

Functional Language and Product Claims

"Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a

claim or claim limitation [Emphasis in original.]” MPEP §2106 II C. Functional recitation(s) using the word “for” has been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJESH KHATTAR whose telephone number is (571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/R. K./
Examiner, Art Unit 3693

Application Number**Application/Control No.**

10/830,010

Examiner

RAJESH KHATTAR

**Applicant(s)/Patent under
Reexamination**

HUANG, SHENG-YU

Art Unit

3693